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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,200	04/18/2005	Roberto D'Alessio	17722 (PC27004)	5147
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Peter I Bernstein Scully Scott Murphy & Presser Suite 300 400 Garden City Plaza Garden City, NY 11530				
EXAMINER				
HAYLIN, ROBERT H				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
08/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/505,200

Applicant(s)

D'ALESSIO ET AL.

Examiner

ROBERT HAVLIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 23-26 and 28-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 21 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date 6/6/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

**Status of the claims:** Claims 1-13, 21-32 are currently pending. Claims 1-12, 23-26, and 28-32 were withdrawn. Claims 13, 22, and 27 were amended. Claims 14-21 were cancelled.

**Priority:** This application is a 371 of PCT/EP03/01594, filed 02/18/2003, which claims benefit of US Provisional Application No. 60/357,918, filed 02/19/2002.

**IDS:** The IDS filed on 6/6/08 was considered. Several of the references were not in English and no translation was provided, thus they were not considered.

### RESPONSE TO APPLICANT ARGUMENTS

The examiner has considered the document referred to as "Exhibit A" filed on 5/23/08 wherein the allegedly commercially available compounds are listed with a name, MW and CAS (if available) and nothing more, no source, reference, or vendor, etc.. Because no source, reference, or vendor was listed along with the compounds, the examiner concludes that while some may be commercially available the document is not persuasive as to the availability of all compounds listed therein.

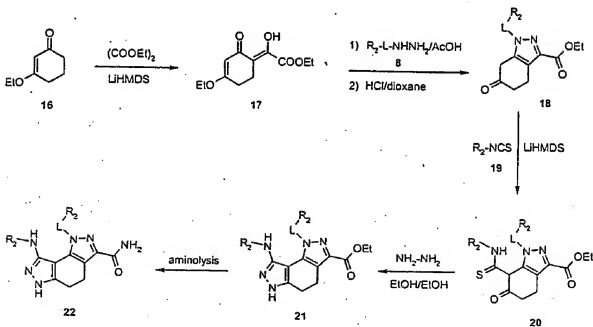
1. Claims 13, 21, and 27 were rejected under 35 USC 112 1<sup>st</sup> paragraph as failing to comply with the written description requirement.

Applicant has amended the claim scope to a genus which appears to have written description support in the specification for variables A, r, and L. Applicant argues that the variable R2 has sufficient 112 support because the scheme on page 17 of the specification teaches a generic method of making the claimed products with

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commercially available isothiocyanates. To support this assertion, applicant provided a list of allegedly commercially available isothiocyanates. However, the cited generic scheme III would pose numerous problems in utilizing the cited compounds because of the subsequent steps. For example, March (March's Advanced Organic Chemistry, 5<sup>th</sup> ed. (2001)) on pages 1192-93 teaches that hydrazine can react with ketones and aldehydes to produce unwanted products other than the ring formation desired. Similarly, the aminolysis step would also cause unwanted side reactions depending on the R<sub>2</sub>-NCS used.

### SCHEME III



Therefore, one of ordinary skill in the art would not readily understand that applicants had possession of the entire scope of R<sub>2</sub> as currently claimed. As mentioned in the prior office action and in the interview of 1/16/08, the scope of R<sub>2</sub> supported by the

original disclosure includes phenylamino and possibly more depending on the problems one of ordinary skill in the art might encounter with the disclosed methods of making the compounds as discussed above. Therefore, one of ordinary skill in the art would not appreciate that applicants possessed the entire scope of the claims.

For the aforementioned reasons, this rejection is maintained.

### ***Conclusion***

2. The claims are not in condition for allowance. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626